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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/716,247      | 11/17/2003  | Farah D. Morton      | 9241.03             | 5210             |

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EXAMINER

HEWITT, JAMES M

| ART UNIT | PAPER NUMBER |
|----------|--------------|
| 3679     |              |

DATE MAILED: 07/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                                      |   |  |
|------------------------------|--------------------------------------|---|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/716,247 | <b>Applicant(s)</b><br>MORTON, FARAH D. |  |
|                              | <b>Examiner</b><br>James M. Hewitt   | <b>Art Unit</b><br>3679                 |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 May 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-75 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 13-15 and 55-61 is/are allowed.
- 6) ☒ Claim(s) 16, 18, 33-34, 62-75 is/are rejected.
- 7) ☒ Claim(s) 1-12, 17, 19-32 and 35-54 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Reissue Applications*

While there is concurrent litigation related to this reissue application, action in this reissue application will NOT be stayed because of applicant's request that the application be examined at this time. Due to the related litigation status of this reissue application, EXTENSIONS OF TIME UNDER THE PROVISIONS OF 37 CFR 1.136(a) WILL NOT BE PERMITTED.

As, the patent sought to be reissued by this application is involved in litigation, any documents and/or materials which would be material to the patentability of this reissue application are required to be made of record in reply to this action.

Due to the related litigation status of this application, EXTENSIONS OF TIME UNDER THE PROVISIONS OF 37 CFR 1.136(a) WILL NOT BE PERMITTED DURING THE PROSECUTION OF THIS APPLICATION.

Claims 16-18, 33-34, 62-69 and 71-75 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Pannu v. Storz Instruments Inc.*, 258 F.3d 1366, 59 USPQ2d 1597 (Fed. Cir. 2001); *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in

Art Unit: 3679

the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

With respect to claim 16, the limitation requiring said cover to extend beyond the opposite end of said base panel has been omitted and thus provides the "broadening aspect" in claim 16. In the original application, this limitation was presented in the amendment filed 2/5/01 to obviate the rejection of claim 1 (35 U.S.C. 103(a) rejection in view of Antosko and Schrieber) in the office action of 10/6/00.

With respect to claim 18, the limitation requiring said cover to extend beyond the opposite end of said base panel has been omitted and thus provides the "broadening aspect" in claim 18. In the original application, this limitation was presented in the amendment filed 2/5/01 to obviate the rejection of claim 1 (35 U.S.C. 103(a) rejection in view of Antosko and Schrieber) in the office action of 10/6/00.

With respect to claims 33 and 34, the limitation requiring the pad to extend beyond the base panel has been omitted and thus provides the "broadening aspect" in claims 33 and 34. In the original application, this limitation was presented in the amendment filed 2/5/01 to obviate the rejection of claim 1 (35 U.S.C. 103(a) rejection in view of Antosko and Schrieber) in the office action of 10/6/00.

With respect to claim 62 (and claims 63-68), the limitation requiring the pad to extend beyond the base panel has been omitted and thus provides the "broadening aspect" in claims 62 and 63-68. In the original application, this limitation was presented in the amendment filed 2/5/01 to obviate the rejection of claim 1 (35 U.S.C. 103(a) rejection in view of Antosko and Schrieber) in the office action of 10/6/00.

With respect to claim 69 (and claims 71-75), the limitation requiring the cover to fit over the base panel, side walls and end wall of said unit and the limitation requiring the pad to fit on top of said cover has been omitted and thus provides the "broadening aspect" in claim 18. In the original application, this limitation was presented in the amendment filed 2/5/01 to obviate the rejection of claim 8 (35 U.S.C. 103(a) rejection in view of Antosko and Schrieber) in the office action of 10/6/00.

### ***Claim Objections***

Claims 18-28, 31-32, 35-37, 41, 47-54 and 69-75 are objected to because of the following informalities:

In claim 18 line 6, the phrase "of the two" should be inserted before "longitudinal".

In claim 19 line 7, the phrase "of the two" should be inserted before "longitudinal".

In claim 31 line 12, the phrase "said pad configured to have a proximal end abut said end panel" should be deleted as it is redundant.

In claim 35 line 5, the phrase "of the two" should be inserted before "longitudinal".

In claim 36 line 5, the phrase "of the two" should be inserted before "longitudinal".

In claim 37 line 5, the phrase "of the two" should be inserted before "longitudinal".

In claim 41 line 1, one instance of "wherein" should be deleted.

In claim 42 line 1, one instance of "wherein" should be deleted.

In claim 69 line 11, "wall" should be "panel" and "said other end panel" should be "the other end panel".

In claim 71 line 2, "panel" should be "panels".

In claim 72 line 2, "panel" should be "panels".

In claim 73 line 2, "panel" should be "panels".

In claim 74 line 2, "panel" should be "panels".

In claim 75 line 1, "panel" should be "panels".

Appropriate correction is required.

Claims 1-12, 16-30 and 35-54 are objected to under 37 C.F.R. 1.75(i) which states "Where a claim sets forth a plurality of elements or steps, each element or step of the claim should be separated by a line indentation."

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 37, 44, 47, 52 and 75 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains

subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In claim 37 line 8, reciting that the cover has an opening therein corresponding to the position of said night light is considered new matter not supported by the original disclosure.

In claim 44 lines 1-2, reciting that the cover has an opening therein corresponding to the position of said night light is considered new matter not supported by the original disclosure.

In claim 47 lines 1-2, reciting that at least one strap is provided in one of said walls for securing the unit in place is considered new matter. This limitation corresponds only to the embodiment depicted in Figure 14. And the embodiment in Figure 14 does not allow for the pad to extend beyond the base panel, as recited in claim 19, from which claim 47 depends.

In claim 52 lines 1-2, reciting that the cover has an opening therein corresponding to the position of said night light is considered new matter not supported by the original disclosure.

In claim 75 lines 2-3, reciting that the integral unit (comprising said end panel, said first and second side panels) is detachable from said base panel is considered new matter not supported by the original disclosure.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 69 and 71-75 are rejected under 35 U.S.C. 102(b) as anticipated by Antosko (US 5,115,524).

As is clear from the figures, Antosko discloses the portable infant bed as claimed in detail in claims 69 and 71-75. Antosko's bed includes a base panel, two upwardly disposed side panels and two end panels, and wherein there is a gap (as at 29 seen for example in Figures 2 and 3) between a side panel and an end panel, and a pad.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 33-34, 62-68 and 70 are rejected under 35 U.S.C. 103(a) as being unpatentable over Antosko (US 5,115,524) in view of Linge (US 5,675,853).

Antosko discloses a portable infant bed (10) as claimed in detail in claims 33-34, 62-68 and 70, with the exception of the claimed fabric cover covering the unit. Antosko's infant bed is made from a flat sheet of foldable material such as cardboard.



Art Unit: 3679

Linge teaches a portable infant bed which includes a removable, washable, form fitting fabric cover (38) that is used to protect the underlying bed. In view of Linge's teaching, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Antosko with a removable, form fitting, fabric cover in order to protect the bed from being soiled.

Claims 33-34 and 62-68 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lerner (US 3,336,608) in view of Linge (US 5,675,853).

Lerner discloses a portable infant bed as claimed in detail in claims 33-34 and 62-68, with the exception of the claimed fabric cover covering the unit. Lerner's infant bed is covered with a plastic cover (30). Linge teaches a portable infant bed which includes a removable, washable, form fitting fabric cover (38) that is used to protect the underlying bed. In view of Linge's teaching, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Lerner with a removable, fabric cover since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

### ***Response to Arguments***

Applicant's arguments filed 5/18/05 with respect to the 35 U.S.C. 251 rejections of claims 16-18 and 20-28 have been fully considered and are persuasive. Those particular 251 rejections have been withdrawn.

***Allowable Subject Matter***

Claims 13-15 and 55-61 are allowed.

Claims 1-12, 17, 19-32 and 35-54 are objected to but would be allowable if rewritten to overcome the above-noted objections (see ***Claim Objections*** above).

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James M. Hewitt whose telephone number is 571-272-7084.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel Stodola can be reached on 571-272-7087. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
**JAMES M. HEWITT**  
**PRIMARY EXAMINER**